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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,145	05/30/2000	Michael Underwood	GOVD-001	1308

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,145

Applicant(s)

UNDERWOOD ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to Applicant's communication filed on August 25, 2003 (Paper No. 3). Amendments to claim 1 have been entered. Rejections of claims 1-5 made under 35 USC § 112 are withdrawn in view of the amendments to claim 1. Claims 1-9 are pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear from claims 6 and 8 as presently stated as to how the method would work if the condition "if the buyer profile code of the at least one buyer does not match the first asset profile code" is met. Would the buyer be offered the asset for sale and bids accepted from the buyer without displaying the asset to the buyer or is matching of buyer profile code and asset profile code essential before the offering and bidding takes place? This is not clear in the way the claims are presently stated. Claim 7 is rejected because it depends on the rejected claim. Correction/Clarification is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082) in view of Godin et al (US Patent 5,890,138).

With reference to claims 1 and 3 Silverman discloses a method comprising the steps of: (a) receiving seller input comprising a first asset profile code for the asset, wherein the first asset profile code comprises at least one community restriction which must be met by a buyer before the buyer is authorized to purchase the asset; (b) retrieving information provided by at least one buyer, the information comprising a buyer profile code; (c) comparing the buyer profile code of the at least one buyer with the first asset profile code to determine whether the buyer profile code of the at least one buyer matches the first asset profile code; (d) if the buyer profile code of the at least one buyer matches the first asset profile code, performing the steps comprising: (1) displaying the asset to the at least one buyer; (2) offering the asset for sale to the at least one buyer; (3) accepting bids on the asset from the at least one buyer; (See Silverman Column 4 lines 4-27 and Claim 9). The minimum ranking is a community restriction, which must be met by a buyer before the buyer is authorized to purchase the asset; displaying potential transaction includes displaying the asset to the buyer and the trading includes the steps of offering the asset for sale and accepting bids on the asset.

Silverman does not explicitly teach the steps of concluding an auction conducted on the Internet at least upon expiration of a seller-defined time period for completing the auction and determining a highest bid from the bids accepted during the auction.

Godin teaches the steps of concluding the auction at least upon expiration of a seller-defined time period for completing the auction (See Godin Column 3 lines 31-38) and determining a highest bid from the bids accepted during the auction (See Godin Column 1 lines 18-20) wherein the auction is conducted on the Internet (See Godin Column 3 lines 14-21).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings of Godin to the invention of Silverman. The combination of the disclosures taken as a whole suggests that both the seller and the potential buyer would benefit from the knowledge that their requirements are properly matched and they would thereby save valuable time and effort in not pursuing deals where there is no proper matching and the seller would save time by defining a closing time for auction if there are no proper bids.

With reference to claim 2, Silverman teaches a method of claim 1 wherein the first asset profile code further comprises at least one asset restriction, which must be met by a buyer before the buyer is authorized to purchase the asset (See Silverman Column 4 lines 20-23).

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082) in view of Godin et al (US Patent 5,890,138) and further in view of Prince (Reference U).

With reference to claims 4 and 5, Silverman and Godin combined teach a method of claim 1 as discussed above.

Silverman and Godin combined do not explicitly teach the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met.

Prince teaches the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met (See Prince Page 64). Strike price or Reserve Price protects a seller's investment or belief of the value of the item.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met to the disclosure of Silverman and Godin. The combination of the disclosures taken as a whole suggests that it would help the seller protect his/her investment or belief of the value of the item.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082) in view of Godin et al (US Patent 5,890,138), further in view of Prince (Reference U) and further in view of Johnson et al (US Patent 6,484,158 B1).

With reference to claims 6 and 7, Prince, Silverman and Godin combined teach a method of claim 4 as discussed above including the steps of: comparing the highest bid with the strike price, whereby if the highest bid is less than the strike price, there is no winner; a second asset profile code comprises at least one community restriction, and the second asset profile code is different from the first asset profile code (See Silverman Column 4 lines 41-47), retrieving information provided by at least one buyer, the information comprising a buyer profile code; comparing the buyer profile code of the at least one buyer with a second asset profile code to determine whether the buyer profile code of the at least one buyer matches the second asset profile code; if the buyer profile code of the at least one buyer matches the second asset profile code, displaying the asset to the at least one buyer; offering the asset for sale to the at least one buyer; accepting bids on the asset from the at least one buyer; if either the

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seller-defined time period for completing the auction has expired or the seller-defined strike price is met, concluding the auction; and determining a highest bid from the bids accepted during the auction (See discussion of claims 1, 4 and 5 above; and wherein the second asset profile code further comprises at least one asset restriction, which must be met by a buyer before the buyer is authorized to purchase the asset (See Silverman Column 4 lines 41-47).

Prince, Silverman and Godin combined do not explicitly teach the step of assigning the asset a second asset profile code.

Johnson teaches the step of assigning the asset a second asset profile code; the second asset profile code is different from the first asset profile code (See Johnson Column 5 lines 15-32).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the step of assigning the asset a second asset profile code to the combined disclosures of Prince, Silverman and Godin. The combination of the disclosures taken as a whole suggests that it would help the system maintain all the information about the asset without requiring substantial changes to the information stored about the asset in the database.

With reference to claims 8 and 9 the applicant is respectfully directed to the discussion of claims 6 and 7 above.

Response to Arguments

8. With reference to Applicants' arguments pertaining to rejections made under 35 USC § 112, second paragraph, rejections of claims 1-5 made under 35 USC § 112 are withdrawn in view of the amendments to claim 1. However it is not clear from claims 6 and 8 as presently stated as to how the method would work if the condition "if the buyer profile code of the at least

one buyer does not match the first asset profile code” is met. Would the buyer be offered the asset for sale and bids accepted from the buyer without displaying the asset to the buyer or is matching of buyer profile code and asset profile code essential before the offering and bidding takes place? This is not clear the way the claims are presently stated. Claim 7 is rejected because it depends on the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine as provided in the rejections would have been obvious to one with ordinary skill in the art.

In response to applicant's argument that Silverman is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Silverman is concerned with the problem of pre-qualifying the parties to the transaction before displaying the details. The current invention is also concerned with pre-qualifying buyers before they are displayed the details.

Hence Silverman is analogous art.

Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of

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a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
November 27, 2003

Richard Weisberger
Primary Examiner

